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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/182,862 10/21/98 CHAO

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MM92/0522

EXAMINER

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MAI, H

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

GPO:2002-070001

Office Action Summary	Application No.	Applicant(s)	
	09/182,862	CHAO, RICHARD	
	Examiner	Art Unit	
	Huy K. Mai	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 April 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,8,12,36-41 and 67-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-3,12,28,67-72 and 74-89 is/are allowed.
- 6) Claim(s) 36-41 is/are rejected.
- 7) Claim(s) 73 is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18,25,29.
- 18) Interview Summary (PTO-413) Paper No(s). _____.
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statements filed on Dec. 1st, 2000 and April 2 & 12, 2001 are acknowledged.

Oath/Declaration

2. The supplemental reissue declaration filed on March 29, 2001 is objected because of containing the language of Fig. 8 (paragraph VI) and "at least one arm for extending over said upper side portion" (paragraph VIII). Since the cancellation of Fig. 8 and the remove the language "at least one arm for extending over said upper side portion" from claims as amended in the amendment filed on April 20, 2001, the language in the paragraphs VI & VII of the supplemental declaration is inappropriate and should be removed.

The examiner agreed that the supplemental declaration is in complete compliance with the reissue rules as argued. Therefore, the observations/rejections set forth paragraphs #2 and 3 of the July 1999 Office action (hereinafter the 1999 Office action) have been withdrawn.

3. Regarding the first declaration of RICHARD J. SAMUELS filed on November 27, 2000 in considering the meetings of the Le Coane Group to determine whether the Twin-Come documents is available as a prior art.

(I) The R. J. Samuels declaration does not prevail the prior art "Twin-Come" documents which are printed publication and were public accessible (as discussed in the 1999 action) in view of *Garret Corp. v. United States*, 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl. 1970) ("While distribution to government agencies and personnel alone may not constitute publication ... distribution to commercial companies without restriction on use clearly does.")

Mr. Samuels states in paragraph (8) that "Sometimes they (Groups) are associations of manufacturers and suppliers, and *sometimes they are associations of manufacturers and distributors, as in the case of the Le Coane Group*" and in paragraph (27) that "I have read all of the Japanese language materials concerning the meeting of the Le Coane Group referred in the declarations of Messrs ... and I have read the organizational document (or *kisoku*) of the Le Coane Group in the original Japanese ... it is my opinion that *the Le Coane Group is a Pentax-sponsored forum for the exclusive interaction between Pentax and its distributors.*" Neither the Samuels' declaration nor the meetings of the Le Coane Group indicate a restriction on use the

☒ Twin-Come products. Thus, it is clear that the distribution of the Twin-Come products to its
☒
☒ distributors without restriction on use constitute publication. See *Garret Corp. v. United States*,
☒
☒ 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl. 1970).

(II) Further, in consideration of the Twin-Come documents and the R. J. Samuels declaration, they do not constitute a confidential from public accessible instead of the Le Coane Group meetings were confidential from a foreign competitor as stated by Mr. Samuels in his declaration.

Mr. Samuels states in paragraph (23) that "I thought particularly telling Mr. Sudo's reaction to Mr. Gholz's question about whether he would feel free to disclose to a foreign competitor a Pentax disclosure to the Le Coane Group that Pentax was going to introduce a new product to the next meeting of the IOFT. As Mr. Sudo said, so doing would be dishonorable". Then, Mr. Samuels concludes "the information conveys to the members of the Le Coane Group by Pentax was subject important "strings" of confidential." And based on the claim on page 71 of the transcription of Mr. Fukuwa's deposition, Mr. Samuels states in paragraph (27) that "the non-

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Pentax members of the Le Coane Group are in that group to build trust between themselves and Pentax and sharing confidential information is a tried and true way to do that – in Japan as in the United States.” It appears to the examiner that the subject important “strings” of confidential and confidential information of the Le Coane Group in the R. J. Samuels declaration were confidential from the foreign competitor but not from the public accessible because of the evidence in the Twin-come documents as discussed in the 1999 Office action. The evidence from the Twin-come documents show that the meeting (of the Le Coane Group) was conducted at IOFT at the same time as while the Twin-Come products of Pentax was displayed and sold at [REDACTED] IOFT in October 1995. The evidence also show that the Twin-Come products, at least models, of [REDACTED] Pentax were delivered to the individuals as well as the large retailers about October 1995. It is [REDACTED] clear to the examiner that the Twin-come documents including the products and/or the meetings [REDACTED] of the Le Coane Group were not restricted from use, display and sale. In another word, the Twin- [REDACTED] come documents were public accessible.

[REDACTED] Therefore, the R. J. Samuels declaration does not prevail the prior art “Twin-Come” documents [REDACTED] in view of *Garret Corp. v. United States*, 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl. 1970) [REDACTED] for the reasons as discussed above.

Drawings

4. The cancellation of the newly added Fig. 8 is acknowledged.

Claim Objections

5. Claim 73 is objected to because of the following informalities: The phrase “said auxiliary spectacle” (claim 73, line 7) should read –said spectacle frame--; otherwise, the phrase “said auxiliary spectacle” has no antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 40,41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations “the first magnetic members are not in contact with the second magnetic members” in dependent claims 40,41 take into with the limitations in claims 36,39, where claims 40,41 depend from, render claims 40,41 unclear as how the first magnetic members are not in contact with the second magnetic members? There is no means to support for the first magnetic members are coupled to, but not in contact with, the second magnetic members.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 36-41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nishioka (5,642,177).

Nishioka discloses in Figs. 1-3, column 2, lines 8-59, an eyeglass device comprising a primary spectacle frame (5a) including two first magnetic members (7) and an auxiliary spectacle frame (1a) including two second magnetic members (3) each secured to one of the auxiliary side

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portions for coupling on a horizontal position with one of the first magnetic members (7), the horizontal position being substantially perpendicular to a front surface of the primary spectacle frame (5a) (NOTE: the horizontal position is where the first magnetic member coupled to the second magnetic member along the line from the center of the first magnetic member (7) to the center of the second magnetic member (3). The line and/or the horizontal position being substantially perpendicular to a front surface of the primary spectacle frame (5a)).

Regarding claims 40,41, due to lacking the clarity of how are the first magnetic members not in contact with the second magnetic members, as discussed above, the limitations in claims 40,41 are inherently included in the Nishioka's device.

Allowable Subject Matter

- 10. Claims 1-3,12,28,67-72,74-89 are allowed.
- 11. Claim 73 would be allowable if overcome the objection of minor informality.

Response to Amendment

- 12. The declaration/affidavit of David Chao under 37 CFR 1.131 (see exhibit #4) filed on April 20, 2001 with the evidence (see exhibits #8-10) and the facts fount in the interference 104,051, papers #149,185 are sufficient to overcome the Twin-come documents reference.

Conclusion

- 13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Huy K. Mai whose telephone number is (703) 308-4874. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

HKM/
May 17, 2001



Huy Mai
Primary Examiner